

Application No.: 09/678,

Patent No. 5,715,173 by issuing a Notice of References Cited that includes U.S. Patent No. 5,715,173.

Applicants also note that the Supplemental Information Disclosure Statement and cited art filed April 15, 2002, has not been acknowledged. Enclosed herewith are copies of the Information Disclosure Statement, PTO-1449 Form and stamped return postcard acknowledgement. Applicants hereby respectfully request that the Examiner clarify the record by acknowledging receipt of the Information Disclosure Statement filed April 15, 2002, and that the Examiner provide an appropriately initialed copy of the PTO-1449 form indicating consideration of the cited prior art.

Claims 1-3 and 8 are rejected under 35 U.S.C. § 103 for obviousness predicated upon JP 2000-200766A (hereinafter Sumitomo) apparently in view of Shinohara et al., U.S. Patent No. 6,007,638 (hereinafter Shinohara)

In the third enumerated paragraph of the Office Action, the Examiner asserted Sumitomo discloses the compound expressed in the general formula, $\text{HO}-((\text{EO})_x-(\text{PO})_y)_z\text{-H}$, except for the claimed values of the integers x, y, and z. The Examiner then concluded that one having ordinary skill in the art would have been motivated to modify the cleaning liquid of Sumitomo in view of Shinohara "for the purpose of improving the detergency of the surfactant on the treated surface by combining oxyethylene and oxypropylene." This rejection is respectfully traversed.

Applications note that the publication date of the Sumitomo reference is July 18, 2000. The filing of a foreign priority application under 35 U.S.C. § 119 is a constructive reduction to

practice of the invention for purposes of establishing priority for a U.S. application. **In re Mulder**, 716 F.2d 1542, 219 USPQ 189 (Fed. Cir. 1983). Thus, the U.S. application may use the filing date of the foreign application as the date of the invention to establish priority to antedate a prior art reference. **In re Gosteli**, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989). As acknowledged in the first page of the Office Action, Applicants submitted a claim of priority to a foreign application with a filing date of October 6, 1999. As the publication date of Sumitomo is July 18, 2000, Applicants have antedated the applied prior art of Sumitomo. A certified English-language translation of the priority document is enclosed.

By antedating the applied prior art of Sumitomo, Applicants respectfully submit that the Examiner's rejection has been traversed. Therefore, Applicants respectfully solicit the withdrawal of the rejection of claims 1-3 and 8 under 35 U.S.C. § 103 for obviousness predicated upon Sumitomo in view of Shinohara.

Claims 4-7 are rejected under 35 U.S.C. § 103 for obviousness predicated upon Sumitomo in view of Shinohara, and further in view of Nakajima et al., U.S. Patent No. 5,715,173 (hereinafter Nakajima)

In the fourth enumerated paragraph of the Office Action, the Examiner asserted Sumitomo and Shinohara substantially disclose the claimed cleaning agent except for failing to specify the process parameters recited in claims 4-7. The Examiner then concluded that one having ordinary skill in the art would have been motivated to modify the cleaning liquid of Sumitomo and Shinohara in view of Shinohara "for the purpose of controlling the solution used in treating a substrate." This rejection is respectfully traversed.

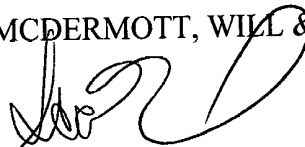
As previously discussed, the applied prior art of Sumitomo has been antedated. Thus, Applicants respectfully submit that the Examiner's rejection has been traversed. Therefore, Applicants respectfully solicit the withdrawal of the rejection of claims 1-3 and 8 under 35 U.S.C. § 103 for obviousness predicated upon Sumitomo in view of Shinohara.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417, and please credit any excess fees to such deposit account.

Respectfully submitted,

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